

**REMARKS:**

Claims 1-28 are currently pending in the application.

Claims 1, 5, 11, and 20 stand rejected under 35 U.S.C. § 112, second paragraph.

Claims 1, 3-11, 13-20, and 22-28 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,460,038 to Khan *et al.* ("*Khan*").

Claims 2, 12, and 21 stand rejected under 35 U.S.C. § 103(a) over *Khan* in view of U.S. Patent No. 5,931,900 to Notani *et al.* ("*Notani*").

A Final Office Action in the subject Application was mailed to the undersigned on 14 September 2006, which provides for a response period ending 14 December 2006. The Applicants filed an Amendment After Final on 10 November 2006, within two (2) months of the date of the Final Office Action. An Advisory Action was mailed to the undersigned on 5 January 2007. The Advisory Action stated that the proposed Amendments filed on 10 November 2006 are sufficient to overcome the rejection of Claims 1, 5, 11, and 20 under 35 U.S.C. § 112, second paragraph. (5 January 2007 Advisory Action, Page 1). The Advisory Action further stated that the proposed Amendments filed on 10 November 2006 will only be entered for the purposes of Appeal. The Applicants respectfully reiterate here the arguments set forth in the Amendment After Final filed on 10 November 2006, as if fully set forth herein.

By this Amendment, independent Claims 1, 11, and 20 have been amended in order to expedite prosecution of the present application and to more particularly point out and distinctly claim the Applicants invention. By making these amendments, the Applicants make no admission concerning the merits of the Examiner's rejection, and respectfully reserve the right to address any statement or averment of the Examiner not specifically addressed in this response. Particularly, the Applicants reserve the right to pursue broader claims in this Application or through a continuation patent application. No new matter has been added.

**REJECTION UNDER 35 U.S.C. § 112:**

Claims 1, 5, 11, and 20 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite.

Specifically, the Final Office Action alleges that independent Claims 1, 11, 20 are indefinite for failing to particularly point and distinctly claim the subject matter which applicant regards as the invention because it is allegedly not clear what is meant by each seller database being distinct in the distributed plurality of seller databases. (14 September 2006 Final Office Action, Page 13). The Applicants respectfully disagree. Nonetheless, in order to expedite prosecution of the present application, the Applicants have amended independent Claims 1, 11, and 20 to state “different” rather the distinct. Support for this amendment may be found in numerous places within the Specification, including page 12, lines 10-14 and page 23, lines 15-26. The Applicants respectfully submit that the amendments to independent Claims 1, 11, and 20 are not necessitated by any prior art and is unrelated to the patentability of the present invention.

The Applicants have also amended dependent Claim 5 to correct the admitted language in the previous response. Therefore, the phrase “different hierarchies” has been added to dependent Claim 5. Support for this amendment may be found in numerous places within the Specification, including page 12, line 25 – page 13, line 9.

The Applicants respectfully submit that Claims 1, 5, 11, and 20 are considered to be in full compliance with the requirements of 35 U.S.C. § 112. The Applicants further respectfully submit that Claims 1, 5, 11, and 20 are in condition for allowance. Thus, the Applicants respectfully request that the rejection of Claims 1, 5, 11, and 20 under 35 U.S.C. § 112 be reconsidered and that Claims 1, 5, 11, and 20 be allowed.

The Applicants note with appreciation that the proposed Amendments filed on 10 November 2006 are sufficient to overcome the rejection of Claims 1, 5, 11, and 20 under 35 U.S.C. § 112, second paragraph.

## **REJECTION UNDER 35 U.S.C. § 103(a):**

Claims 1, 3-11, 13-20, and 22-28 stand rejected under 35 U.S.C. § 103(a) over *Khan* over the Examiner's Official Notice. Claims 2, 12, and 21 stand rejected under 35 U.S.C. § 103(a) over *Khan* in view of *Notani*.

Although the Applicants believe Claims 1-28 are directed to patentable subject matter without amendment, the Applicants have amended independent Claims 1, 11, and 20 to more particularly point out and distinctly claim the Applicants invention. By making these amendments, the Applicants do not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of these claims under 35 U.S.C. § 103(a), as set forth in the Final Office Action.

The Applicants respectfully submit that the ***amendments to independent Claims 1, 11, and 20 have rendered moot the Examiner's rejection of these claims and the Examiner's arguments in support of the rejection of these claims***. The Applicants further respectfully submit that amended independent Claims 1, 11, and 20 in their current amended form contain unique and novel limitations that are not taught, suggested, or even hinted at in *Khan*, *Notani*, or the Examiner's Official Notice, either individually or in combination. Thus, the Applicants respectfully traverse the Examiners obvious rejection of Claims 1-28 under 35 U.S.C. § 103(a) over the proposed combination of *Khan*, *Notani*, or the Examiner's Official Notice, either individually or in combination.

## **The Proposed *Khan*-Official-Notice Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicants Claims**

For example, with respect to amended independent Claim 1, this claim recites:

An electronic commerce system for facilitating an electronic commerce transaction, the electronic commerce system comprising:  
a global content directory for providing a plurality of buyers access to a distributed plurality of seller databases, each seller database associated with a corresponding seller and different from other seller databases in the distributed plurality of seller databases, the global content directory comprising:

***a directory structure comprising a plurality of product classes organized in a hierarchy, each product class categorizing a plurality of products and defining one or more attributes of the products categorized in the product class;***

***one or more pointers associated with each product class in the plurality of product classes, each pointer identifying the seller database in the distributed plurality of seller databases in which product data enabling a product transaction is stored for products associated with the product class, the seller database identified by the pointer being associated with its corresponding seller and being distinct from the other seller databases in the distributed plurality of seller databases; and***

***a search interface operable to communicate a search query for product data to the one or more seller databases identified by the one or more pointers associated with the selected product class, each seller database associated with its corresponding seller and distinct from the other seller databases in the plurality of seller databases;***

***a selection of a product class received from one of the plurality of buyers;***

***in response to the selection of the product class received from one of the plurality of buyers, communicating a search query for product data to one or more seller databases identified by one or more pointers associated with the selected product class; and***

***in response to communicating a search query for product data to one or more seller databases identified by one or more pointers associated with the selected product class, receive address information associated with a seller database associated with a seller of the selected product, the seller database including product data for the selected product, the address information enabling one of the plurality of buyers to communicate with the seller associated with the seller database to conduct a commerce transaction relating to the selected product.*** (Emphasis added)

Amended independent Claims 11 and 20 recite similar limitations. *Khan* or the Examiner's Official Notice either individually or in combination, fail to disclose each and every limitation of independent Claims 1, 11, and 20.

The Applicants respectfully submit that *Khan* fails to teach or suggest amended independent Claim 1 limitation "***in response to communicating a search query for product data to one or more seller databases identified by one or more pointers associated with the selected product class, receive address information associated with a seller database associated with a seller of the selected product, the seller***

**database including product data for the selected product, the address information enabling one of the plurality of buyers to communicate with the seller associated with the seller database to conduct a commerce transaction relating to the selected product.”** The Final Office Action points to column 10, lines 27 through column 11, line 28 of *Khan* as teaching the limitation of **“communicate address information associated with a seller database associated with a seller of the selected product, the seller database including product data for the selected product, the address information enabling one of the plurality of buyers to communicate with the seller associated with the seller database to conduct a commerce transaction relating to the selected product.”** However, this passage of *Khan* fails to teach or suggest this limitation.

The cited passage of *Khan* merely teaches programmable bookmarks. A user visits a webpage, creates a bookmark, wherein the bookmark is programmable. The bookmark may be programmed to have an alarm. The user chooses a time in the future or a time interval at which the user wishes to revisit the website. At the appointed time, the user is notified or reminded to revisit the website. Additionally, the bookmark can be programmed to publish content updates to the user. In such a case, the user is notified periodically of updates to the website. Other programmable features of the bookmark are detailed in other portions of *Khan*. However, all these passages of *Khan* fail to teach or suggest the limitation of **“in response to communicating a search query for product data to one or more seller databases identified by one or more pointers associated with the selected product class, receive address information associated with a seller database associated with a seller of the selected product, the seller database including product data for the selected product, the address information enabling one of the plurality of buyers to communicate with the seller associated with the seller database to conduct a commerce transaction relating to the selected product.”**

The processes detailed in *Khan* involve a user visiting a website, creating a bookmark and programming the bookmark to perform certain functions in the future based on user specified criteria. *Khan* fails to teach or suggest a search interface for a global content directory wherein the user selects a product from the global content directory, the

selection being sent from the search interface to the seller database as part of a search query. And, in response to sending this query, the user receives information back from the seller database. Instead, Khan teaches programming a bookmark to generate information or notices at preprogrammed times. Khan fails to teach or suggest generating this information or notice in response to the user selecting the product from the global content directory. Thus, Kahn fails to teach or suggest the limitation ***“in response to communicating a search query for product data to one or more seller databases identified by one or more pointers associated with the selected product class, receive address information associated with a seller database associated with a seller of the selected product, the seller database including product data for the selected product, the address information enabling one of the plurality of buyers to communicate with the seller associated with the seller database to conduct a commerce transaction relating to the selected product.”***

The Applicants respectfully submit that *Khan* does not disclose, teach, or suggest amended independent Claim 1 limitations regarding ***“in response to the selection of the product class received from one of the plurality of buyers, communicating a search query for product data to one or more seller databases identified by one or more pointers associated with the selected product class.”*** Specifically, the Final Office Action points to elements 402, 502, and 602 of Figures 4, 5, and 6 of *Khan* as teaching ***“in response to the selection of the product class received from one of the plurality of buyers.”*** However, elements 402, 502, and 602 of Figures 4, 5, and 6 of *Khan* do not teach the ***“in response to the selection of the product class received from one of the plurality of buyers”***, as recited in amended independent Claim 1. Instead, element 402 teaches that a user is asked a particular date and time to be reminded to visit a website linked to the selected bookmark. In addition, the user, in *Khan*, is not asked anything about a product and the user's response has nothing to do with a product or the user making a product selection from a global content directory. Rather, the user, in *Khan*, is merely reminded to visit a particular website in the future.

Element 502 teaches that a user is queried as to whether the user would like to be notified of updates to the website and a time interval for receiving updates for the website.

Again, the query issued to the user, in *Khan*, **has nothing do with any product**, but rather the query is merely provided for being notified of an update to the website. These updates, regardless of what the update contains, are sent to the user and are **not tied to a product; rather they are tied to the website**. Thus, the updates or generating the updates are not equivalent to a user making a product selection from a global content directory. Element 602 teaches a “pulled update” feature, wherein a user is asked for keywords related to website. When the keyword is detected on the website, the user, in *Khan*, is notified that the word now appears on the webpage. Thus, the updates or generating the updates are not equivalent to a user making a product selection from a global content directory. Therefore, for at least the reasons set forth above, *Khan* does not teach, suggest, or even hint at **“in response to the selection of the product class received from one of the plurality of buyers,”** as recited in amended independent Claim 1.

Furthermore, looking at Figure 3 of *Khan*, elements 402, 502, and 602 are performed when a bookmark is created. The bookmark, in *Khan*, is merely a link to a website. However, the limitations of amended independent Claim 1 recite **“in response to the selection of the product class received from one of the plurality of buyers.”** In contrast, a website is not a product class. In addition, creating a bookmark to a website, in *Khan*, is not the same as a user selecting a product class from the global content directory. Thus, even if any of elements 402, 502, or 602 could somehow be construed as buyer queries, which they are not, they are clearly not, elements 402, 502, or 602 do not teach, suggest, or even hint at a selection of product class as they are performed in response to the creation of a bookmark, or link, to a website. Thus, as elements 402, 502, or 602 are performed in response to the creation of a bookmark, or link, to a website, it follows that elements 402, 502, or 602 cannot be equivalent to the selection of a product class (from the global content directory) from one of the plurality of users. Therefore, for at least the reasons set forth above, *Khan* does not teach, suggest, or even hint at **“in response to the selection of the product class received from one of the plurality of buyers,”** as recited in amended independent Claim 1.

Additionally, the Final Office Action States that Figure 10 teaches “**communicating a search query for product data to one or more seller databases identified by one or more pointers associated with the selected product class**,” as Figure 10 allegedly teaches showing the results of a search query for product data, such as cargo pants and a special fare, and therefore a query must have been communicated. The Applicants respectfully disagree. Figure 10 neither teaches “**communicating a search query for product data to one or more seller databases identified by one or more pointers associated with the selected product class**,” nor the results of a search query for product data. As shown in Figure 10, the cargo pants notification and special fares notification are displayed as part of the “service delivery feature”. This feature is explained in greater detail in column 13, line 23 – column 14, line 7 and Figure 9. As taught by *Khan*, according to this service, a user is queried as to whether the user wants to receive sales and marketing information from the website. If so, the user, in *Khan*, is automatically notified of any and all such information. Thus, the notification or result displayed in Figure 10 is due to the user signing up to receive marketing and sales updates for the entire website. *Khan* does not teach, suggest, or even hint at an indication that the marketing and sales data is restricted to a specific selected product class, as recited in amended independent Claim 1. Thus, the information regarding cargo pants and special fares displayed in Figure 10 is not a search result for product data for a selected product class.

Furthermore, while the Final Office Action separates the feature of “**in response to the selection of the product class received from one of the plurality of buyers, communicating a search query for product data to one or more seller databases identified by one or more pointers associated with the selected product class**,” into two parts in order to teach the limitation, none of the passage cited by the Final Office Action disclose, teach, or suggest communicating a search query for product data in response to the selection of the of the product class (form the global content directory) by a buyer. Rather, the Final Office Action seems to cite to passages that allegedly teach a buyer making a product query and a passage that allegedly shows results from a query. Applicants respectfully disagree with the Final Office Action and have argued that none of the cited passages disclose, teach, or suggest a buyer making a query about product due to the **selection of the product from a global content directory** or displaying results of



a communicated product query. However, even if the passages cited by the Final Office Action are assumed to teach a buyer generating a query and the results of a query being shown, ***nowhere is it shown that a product query for product data is sent to a seller database in response to a selection of the that product by the buyer from the global content directory.***

The Applicants further respectfully submit that *Khan* does not disclose, teach, or suggest amended independent Claim 1 limitations regarding ***“a directory structure comprising a plurality of product classes organized in a hierarchy, each product class categorizing a plurality of products and defining one or more attributes of the products categorized in the product class.”*** The Final Office Action states that *Khan* teaches a global content directory even though it does not use this term, as labels are functionally related to the substrate of the article of manufacture and that labels themselves carry little or no patentable weight. Through-out the Final Office Action, directory headers such as “shopping,” “travel,” and “finance” are cited as being allegedly equivalent to the term “product class,” as used in amended independent Claim 1 of the present application. Figure 10 does show these terms (i.e. “shopping,” “travel,” and “finance”) arranged in a directory in hierarchical order. However, ***merely arranging words in a directory in hierarchical order does not make them equivalent to the term product class***, as recited in amended independent Claim 1. Instead, amended independent Claim 1 provides ***“each product class categorizing a plurality of products and defining one or more attributes of the products categorized in the product class”***. *Khan* fails to disclose, teach, or suggest ***“each product class categorizing a plurality of products and defining one or more attributes of the products categorized in the product class”***, as recited in amended independent Claim 1.

As shown in Figure 10 of *Khan*, the category “Shopping” has list of bookmarks, which are links to a websites, for the websites LL Bean, Gap, and LandsEnd. The Applicants are unaware of how “shopping” is a product or product class and how “shopping” categorizes a plurality of products and defines one or more attributes of the products categorized in the product class. Furthermore, how is LL Bean, Gap, and

LandsEnd a “product?” The Final Office Action states, numerous times, that these are “sellers.” (14 September 2006 Final Office Action, Pages 12, 14-17). Also, on page 6, the Final Office Action states that bookmarks are pointers. And, on page 7, the Final Office Action states that the URLs are pointers that are associated with the product class. Thus, at best, the directory structure taught by *Khan* and illustrated in Figure 10 of *Khan* shows a set of pointers arranged in certain categories, ***but does not include or is not even related to a “directory structure comprising a plurality of product classes organized in a hierarchy, each product class categorizing a plurality of products and defining one or more attributes of the products categorized in the product class”***. Thus, for at least the reasons set forth above, the Applicants respectfully submit that the equations forming the foundation of the Examiner’s comparison between *Khan* and amended independent Claim 1 cannot be made. The Applicants further respectfully submit that these distinctions alone are sufficient to patentably distinguish amended independent Claim 1 from *Khan*.

The Applicants still further respectfully submit that the Examiner’s Official Notice fails to cure the acknowledged deficiencies in *Khan*. The Examiner’s Official Notice fails to disclose, teach, or suggest amended independent Claim 1 limitations regarding ***“in response to the selection of the product class received from one of the plurality of buyers, communicating a search query for product data to one or more seller databases identified by one or more pointers associated with the selected product class,”*** and ***“a directory structure comprising a plurality of product classes organized in a hierarchy, each product class categorizing a plurality of products and defining one or more attributes of the products categorized in the product class.”*** Therefore, for at least the reasons set forth above, the Applicants respectfully submit that *Khan* or the Examiner’s Official Notice, either individually or in combination, fails to disclose, teach, or suggest each and every limitation recited in amended independent Claim 1.

### **The Proposed *Khan*-Official-Notice Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicants Claims**

The Applicants respectfully maintain that *Khan* or the Examiner's purported Official Notice, either individually or in combination, fails to disclose, teach, or suggest each and every element of amended independent claims 1, 11, and 20. Thus, the Applicants respectfully maintain the traverse the Examiner's obvious rejection of amended independent claims 1, 11, and 20 under 35 U.S.C. § 103(a) over the proposed combination of *Khan* and the Examiner's Official Notice, either individually or in combination.

The Applicants further respectfully maintain that the Applicants are confused as to what the Examiner is intending to teach by the Official Notice or even the extent in which the Examiner is taking Official Notice. ***The Applicants respectfully request clarification as to the subject matter for which the Examiner is taking Official Notice. The Applicants respectfully traverse the Official Notice because the asserted facts, as best understood by the Applicants, are not supported by substantial documentary evidence or any type of documentary evidence and appear to be the Examiner's opinions formulated using the subject Application as a template, which constitutes impermissible use of hindsight.*** Furthermore, under these circumstances, ***it is inappropriate for the Examiner to take Official Notice without documentary evidence to support the Examiner's conclusion.*** (See MPEP § 2144.03). ***The Applicants respectfully request the Examiner to produce authority for the Examiner's purported Official Notice.***

Only "in limited circumstances," is it "appropriate for an examiner to take official notice of facts not in the record or to rely on common knowledge in making a rejection". (MPEP § 2144.03). "Official notice unsupported by documentary evidence ***should only be taken by the examiner*** where the facts asserted to be well-known, or to be common knowledge in the art are ***capable of instant and unquestionable demonstration as being well-known***. With respect to the subject Application, ***the Examiner's statement*** that "different sellers sell different products and services", ***is not capable of instant and unquestionable demonstration as being well-known or even related to the subject Application.*** (14 September 2006 Office Action, Page 11). As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts

beyond the record which may be taken by the examiner must be '**capable of such instant and unquestionable demonstration as to defy the dispute**' (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 U.S.P.Q. 6 (C.C.P.A. 1961))." (MPEP § 2144.03(A)). (Emphasis Added).

**"It is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based.** *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697. (Emphasis Added). As the court held in *Zurko*, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.* at 1385, 59 USPQ2d at 1697. See also *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002)." (MPEP § 2144.03(A)). "Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that **general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection**). The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. See *Soli*, 317 F.2d at 946, 37 USPQ at 801; *Chevenard*, 139 F.2d at 713, 60 USPQ at 241. The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made." (MPEP § 2144.03(B)). (Emphasis Added).

With respect to the subject Application, the Examiner submits as documentary evidence for the allegation that different sellers sell different products and services and refers to Figure 4A of U.S. Patent No. 7,092,892 to Sobalvarro *et al.* ("*Sobalvarro*"). However, the Examiner's conclusory statement that "different sellers sell different products and services", **does not adequately address the issue that this statement is considered to be common knowledge, well-known in the art, or even related to the subject Application.** The Applicants respectfully submit the following statement, to

further explain why the Examiner's above noticed statement is not considered to be common knowledge or well-known in the art.

**First**, it is not clear what the Examiner means by “**different sellers sell different products**” (i.e. what “**different sellers**” is the Examiner referring to and to what extent does the Examiner purport “**selling different products**” applies to the subject Application). In fact, the limitations recited in amended independent claim 1 are directed to “**a global content directory for providing a plurality of buyers access to a distributed plurality of seller databases**” which are “associated with a corresponding seller and **distinct from other seller databases in the distributed plurality of seller databases**”. It is not clear how the Examiner's Official Notice that “**different sellers sell different products**” relates to the “**distributed plurality of seller databases**” or how it relates to “**providing a plurality of buyers access to a distributed plurality of seller databases**” or even how it is “**distinct from other seller databases in the distributed plurality of seller databases**”.

**Second**, it is not clear how the Examiner's documentary evidence overcomes the presumption that “different sellers sell different products and services” is not considered to be common knowledge, well-known in the art. For example, in Figure 4A, *Sobalvarro* merely provides for an operator to view item descriptions for an inventory list, these items may be a product or a service. The operator in *Sobalvarro* may describe the items as having certain attributes. Therefore, according to *Sobalvarro*, an operator may view and describe an item which may be a product or service, but does not include, involve, or even relate to a “**global content directory for providing a plurality of buyers access to a distributed plurality of seller databases**, each seller database associated with a corresponding seller and **distinct from other seller databases in the distributed plurality of seller databases**”, as recited in amended independent claim 1.

**Third**, as explained above, the Examiner's statement that “**different sellers sell different products**” is not considered to be common knowledge or well-known in the art or even related to the subject Application. The Applicants respectfully submit that the “**global content directory**” recited in amended independent claim 1 is for “**providing a**

***plurality of buyers access to a distributed plurality of seller databases***” and each seller database is associated with a corresponding seller and each seller database is ***“distinct from other seller databases in the distributed plurality of seller databases”***. Thus, the Applicants further respectfully submit that the equations forming the foundation of the Examiner’s comparison between the Examiner’s Official Notice and amended independent claim 1 cannot be made.

***Fourth***, there is simply no disclosure, teaching, or suggestion in *Khan*, *Sobalvarro*, or the Examiner’s Official Notice of a ***“global content directory for providing a plurality of buyers access to a distributed plurality of seller databases”*** which are “associated with a corresponding seller and ***distinct from other seller databases in the distributed plurality of seller databases***”.

The Applicants respectfully submit that the documentary evidence provided by the Office Action mischaracterizes the Applicants invention and does not support the Official Notice taken by the Examiner. In addition, the asserted fact “that ***different sellers sell different products and services***”, is not capable of “instant and unquestionable” demonstration as being well-known. ***The Applicants respectfully request the Examiner to produce actual authority for the Examiner’s statement “that different sellers sell different products and services”, is old and well known and that this relates to the subject Application.***

The Applicants further submit that ***the Applicants have adequately traversed the Examiner’s assertion of Official Notice*** and direct the Examiner’s attention to the pertinent text of the MPEP, which states:

If applicant adequately traverses the examiner’s assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (“[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings” to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2). (MPEP § 2144.03(C)).

Thus, if the Examiner continues to maintain the rejection of amended independent claims 1, 11, and 20 based on the Examiner's Official Notice, ***the Applicants respectfully request that the Examiner provide documentary evidence*** as necessitated by MPEP § 2144.03(C). Furthermore, if the Examiner is relying on personal knowledge to support the finding of what is known in the art, ***the Applicants further request that the Examiner provide an Affidavit or Declaration setting forth specific factual statements and explanation to support the finding*** as further necessitated by MPEP § 2144.03(C).

**The Proposed *Khan-Notani* Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicants Dependent Claims 2, 12, and 21.**

The Applicants respectfully submit that *Khan* or *Notani*, either individually or in combination, fails to disclose, teach, or suggest each and every element of dependent Claims 2, 12, and 21. Thus, the Applicants respectfully traverse the Examiner's obvious rejection of dependent Claims 2, 12, and 21 under 35 U.S.C. § 103(a) over the proposed combination of *Khan* and *Notani*, either individually or in combination.

Claims 2, 12, and 21 depend from independent Claims 1, 11, and 20, respectively. As argued above with respect to amended independent Claim 1, *Khan* fails to disclose, teach, or suggest all the limitations of amended independent Claim 1. *Notani* fails to cure the acknowledged deficiencies of *Khan*. *Notani* fails to disclose, teach, or suggest the amended independent Claim 1 limitations including ***"in response to the selection of the product class received from one of the plurality of buyers, communicating a search query for product data to one or more seller databases identified by one or more pointers associated with the selected product class,"*** and ***"a directory structure comprising a plurality of product classes organized in a hierarchy, each product class categorizing a plurality of products and defining one or more attributes of the products categorized in the product class"***. In addition, the Final Office Action fails to cite to any portion of *Notani* as teaching the limitations recited in amended independent Claim 1. Thus, dependent Claims 2, 12, and 21 are considered patentably distinguishable over the combination of *Khan* and *Notani*.

## **The Applicants Claims are Patentable over the Proposed *Khan*-Official-Notice-*Notani* Combination**

The Applicants respectfully submit that amended independent Claims 11 and 20 include limitations similar to those discussed above in connection with amended independent Claim 1. Thus, amended independent Claims 11 and 20 are considered patentably distinguishable over *Khan*, *Notani*, or the Examiners Official Notice for at least the reasons discussed above in connection with amended independent Claim 1.

With respect to dependent Claims 2-10, 12-19, and 21-28: Claims 2-10 depend from amended independent Claim 1; Claims 12-19 depend from amended independent Claim 11; and Claims 21-28 depend from amended independent Claim 20. As mentioned above, each of amended independent Claims 1, 11, and 20 are considered patentably distinguishable over the proposed combination of *Khan*, *Notani*, and the Examiner's Official Notice. Thus, dependent Claims 2-10, 12-19, and 21-28 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For at least the reasons set forth herein, the Applicants submit that Claims 1-28 are not rendered obvious by the proposed combination of *Khan*, *Notani*, or the Examiner's Official Notice. The Applicants further respectfully submit that Claims 1-28 are in condition for allowance. Thus, the Applicants respectfully request that the rejection of Claims 1-28 under 35 U.S.C. § 103(a) be reconsidered and that Claims 1-28 be allowed.

### **THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:**

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, ***there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.*** Second, there must be a reasonable expectation of success. Finally, ***the prior art reference*** (or references when combined) ***must teach or suggest all the claim limitations.*** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and ***not based on applicant's disclosure.*** *In re Vaeck*, 947 F.2d



488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, ***there must be something in the prior art as a whole to suggest the desirability***, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

**CONCLUSION:**

A Request for Continued Examination (RCE) is being filed in duplicate concurrently herewith to facilitate the processing of this deposit account authorization. **The Commissioner is hereby authorized to charge the \$120.00 One-Month Extension of time fee, as well as the \$790.00 RCE fee, to Deposit Account No. 500777.**

Although the Applicant believes no additional fees are deemed to be necessary; the undersigned hereby authorizes the Commissioner to charge any additional fees that may be required, or credit any overpayments, to **Deposit Account No. 500777**. If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

**Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.**

Respectfully submitted,

2/2/07  
Date



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**CUSTOMER NO. 53184**

**ATTORNEYS AND AGENTS FOR APPLICANTS**

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